

REMARKS

Claims 1-5, 7-11, 13-16 and 19 are currently pending in the present application.

Claims 1-5, 7-11, 13-16 and 19 have been rejected. Claim 11 has been canceled. No claims have been amended. Claims 21-26 are new.

I. Rejections under 35 U.S.C. § 103

Claims 1-5, 7-11, 13-16 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,135,884 to Hedrick, et al. (“Hedrick”) in view of U.S. Patent No. 5,429,361 to Raven, et al. (“Raven”). In particular, the Office Action states, “Hedrick teaches . . . a player tracking device including . . . at least one speaker (col. 8, lines 9-10) . . . a player tracking host (#526); and an information system host (#524).” The Office Action also states, “Hedrick further teaches . . . a top box secondary display for displaying various types of multimedia information . . . that is *located in the proximity of* the player tracking device” (emphasis added), and asserts, “It would have been obvious . . . to incorporate player specific promotional information, as taught by Raven, into the multimedia top box display of Hedrick.” Applicants respectfully traverse these rejections.

Applicants respectfully submit that a *prima facie* case of obviousness has not been made for several reasons. To establish a *prima facie* case of obviousness, there must be A) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine reference teachings. *See, e.g.*, MPEP § 2143. In addition, there must be B) a reasonable expectation of success when making the modification. *See id.* Furthermore, C) the proffered combination of prior art references must teach or suggest all of the claim limitations. *See id.* Applicants respectfully submit that none of these requirements is met by the obviousness rejections as set forth in the Office Action. Applicants also submit that should a *prima facie*

case of obviousness be established, that other factors and/or secondary considerations that serve to rebut such obviousness rejections can be provided. Applicants believe it to be unnecessary to present each of these additional factors and/or secondary considerations at this time, however, since the initial burden of making a *prima facie* case of obviousness has not yet been met, and because the presentation of such factors and considerations ordinarily involves a substantial amount of resources and time. Accordingly, Applicants respectfully reserve the right to present such additional information should a *prima facie* case of obviousness be established.

A Improper Combination of References

The teaching or suggestion to make the claimed combination must be found in the prior art, and not based upon the disclosure of the Applicants. *See* MPEP § 2143. Also, the level of skill in the art cannot be relied upon to provide the suggestion to combine references, and the mere fact that references can possibly be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the claimed combination. *See* MPEP § 2143.01. Although the Office Action states, “It would have been obvious . . . to incorporate player specific promotional information, as taught by Raven, into the multimedia top box display of Hedrick,” the Office Action does not point out where any motivation exists in the prior art to combine these references in the manner prescribed.

In addition, a prior art reference must be considered in its entirety, including portions that would lead away from the claimed invention. *See* MPEP § 2141.02. Applicants note that Raven actually teaches away from the proposed combination, at least to the extent that its relevant display is incapable of displaying multi-media information comprising video or one or more images. Among various limitations, Raven notes in particular that its “DMK 12 houses a 12-character dot-matrix LED display” (col. 3 lines 3-4), and that this “DMK 12 can

receive data at a maximum rate of 2.1 Mhz, which has been found to be sufficient for the intended purposes.” (col. 5, lines 6-8).

Given the extremely limited display means within the player tracking device of Raven and its own admission that its meager transfer rate is “sufficient for the intended purposes,” one of ordinary skill in the art contemplating the entirety of the teachings of Raven would not consider or be motivated to combine Raven with Hedrick to arrive at the display of multi-media information comprising video or one or more images at a player tracking device as is presently claimed. Accordingly, Applicants respectfully submit that no proper motivation to combine references in the manner proffered has been shown, and that at least one of the references themselves teaches away from such a combination, such that a *prima facie* case for obviousness has not been made for at least this reason.

B No Reasonable Expectation Of Success Within The Prior Art

A reasonable expectation of success in making a proposed combination must also be found in the prior art, and similarly cannot be based on the disclosure provided by the Applicants. *See* MPEP § 2143. As in the foregoing section, the Office Action fails to show where any reasonable expectation of success exists in the recited prior art, instead relying upon the disclosure of the Applicants. The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention, however, and Applicants submit that one of skill in the art would simply not consider providing multi-media content on a player tracking device itself as a viable solution to overcoming issues associated with directing specific information to a player while the player is playing or at a gaming device.

In particular, Applicants note that neither Hedrick nor Raven disclose a player tracking device having a player tracking display that is adapted to display multi-media information comprising video or one or more images. The only thing pointed to by the Office Action as being capable of displaying such multi-media content is the secondary

display of Hedrick. Applicants note that while it might be possible for Hedrick to display player tracking information at such a secondary display, that this secondary display is not actually a part of the player tracking device. In fact, Hedrick teaches that its player tracking device 516 has its own display 518, which is preferably “an LED, small LCD, vacuum fluorescent, or dot matrix alphanumeric display.” Similar to that which is taught in Raven, this player tracking device display 518 is incapable of displaying multi-media information comprising video or one or more images, as required by the present claims. Accordingly, Applicants respectfully submit that no reasonable expectation of success in making the proposed combination has been shown to be within the recited prior art, such that a *prima facie* case for obviousness has not been made for at least this reason as well.

C All Claim Limitations Not Within The Prior Art

In order to render a claim as obvious, a purported combination of references must also contain every material element of that claim. *See* MPEP § 2143. Although not yet required because the burden to establish non-obviousness does not switch to Applicants until a *prima facie* case of obviousness has been established, Applicants will nevertheless provide examples of claim limitations that have not been shown to be within the recited prior art for the sake of furthering prosecution. For example, independent claim 1 recites an “information system host arranged to generate multi-media information for presentation by said player tracking device,” while both of independent claims 8 and 19 recite the step of “presenting said multi-media information [] at said gaming machine with said player tracking device.” Furthermore, these independent claims also recite additional elements of a “player tracking device including . . . at least one speaker,” “determin[ing] the eligibility of a player . . . to multi-media information,” a “player tracking host,” and an “information system host,” as well as steps of “transmitting [] multi-media information [] to said player tracking device,” “storing said multi-media information at said player tracking device,” and “periodically

accessing [said] stored multi-media information.” Each of these required elements and their absence from the recited prior art are discussed in greater detail below.

- Multi-Media Presented at Player Tracking Device

The Office Action states, “Hedrick further teaches . . . a top box secondary display for displaying various types of multimedia information . . . that is *located in the proximity of the player tracking device*” (emphasis added). Each of the pending independent claims, however, requires the presentation of multimedia information at a gaming device or machine *by or with* a player tracking device, and not by some other display that might be located in the proximity of the player tracking device. Applicants respectfully submit that the display of multimedia information by or with the player tracking device itself is fundamentally different than a display of such content at some other device, and that the present claims are unambiguous in specifying this element. While the invention of either reference might be practiced with such an advanced feature, neither Hedrick nor Raven discloses the presentation of multimedia on the actual player tracking device itself. Because this material element is missing from the entirety of the purported combination of references, the pending obviousness rejections cannot stand. Accordingly, Applicants respectfully request the withdrawal of the § 103 rejections with respect to all claims for at least this reason.

- Player Tracking Device Speaker

The Office Action also states that “Hedrick teaches . . . a player tracking device including . . . at least one speaker (col. 8, lines 9-10).” A review of Hedrick, however, shows that these speakers are not part of the player tracking device of Hedrick. As noted in Hedrick at column 8, lines 9-10, which refers to Figs. 4a-4d, “Speaker ports 356 are provided on the front lower corners of housing portions 353 and 355,” which are all a part of top box 302. Nothing in Hedrick suggests that these speakers are a part of a player tracking device. Conversely, the primary description and illustration of a player tracking device within

Hedrick shows a player tracking device 516 having a display 518, a reader 520 and a keypad 522, but no speaker (e.g., Fig. 5 and col. 9). Applicants respectfully submit that while the invention of Hedrick might be used with a player tracking device having a speaker, this feature is not affirmatively taught by Hedrick. Accordingly, this material element has not been shown to be present in Hedrick as asserted, such that the pending obviousness rejections cannot stand for at least this additional reason.

- Determining Player Eligibility

The Office Action states that “Hedrick is silent regarding the determination of the eligibility of the player of the gaming device to multimedia information,” and further states that “Raven teaches the display of information to a player which is directly correlated to the information host’s data received regarding that player, via the player tracking input (col. 5, lines 15-37).” The pending independent claims, however, recite elements directed to “determin[ing] the eligibility of a player . . . to multi-media information.” Applicants submit that Raven does not disclose or suggest determining the eligibility of a player to multi-media information in any event, and that it is difficult to perceive Raven as disclosing or suggesting any step of determining player eligibility for any particular display mode. A careful review of the recited passage above does not reveal such an eligibility determination step, and such a step cannot be found elsewhere within Raven. In fact, it would appear that player tracking device displays within Raven could be made to any player in a given display mode, without ever making an eligibility determination for a particular player. Applicants thus respectfully submit that this material element has also not been shown to be present in the prior art.

- Player Tracking Host

The Office Action states, “Hedrick teaches . . . a player tracking device including . . . a player tracking host (#526).” A careful review of Hedrick, however, shows that item 526 is “an optional data collection unit (“DCU”) . . . [with such DCUs on the network adapted to]

act as communications multiplexers for groups of gaming machines, [and] have some limited processing capabilities for the purpose of polling machines, storing and forwarding communications” (col. 9, lines 33-44). Applicants respectfully submit that such a DCU is not a player tracking host, which is a different item that is well known in the art and that is known to have different capabilities and functionalities than a DCU. Although the invention of Hedrick could certainly be practiced with the use of a player tracking host, Applicants respectfully submit that a player tracking host is not of particular importance to Hedrick, and that Hedrick has not been shown to disclose a player tracking host in any event. Applicants thus respectfully submit that this material element has also not been shown to be present.

- Information System Host

Similarly, the Office Action states, “Hedrick teaches . . . a player tracking device including . . . an information system host (#524).” As in the foregoing item, a careful review of Hedrick shows that item 524 is illustrated and described only as a “network” that may be “a casino communications network.” Applicants respectfully submit that while such a casino communications network may include an information system host, that such a host is not an indispensable element of a casino communications network, and that this network is not an information system host in any event. Although the invention of Hedrick could certainly be practiced with the use of an information system host, Applicants respectfully submit that such an information system host is not of particular importance to Hedrick, and that Hedrick has not been shown to disclose an information system host in any event. Applicants thus respectfully submit that this material element has also not been shown to be present.

- Transmitting Multi-Media to Player Tracking Device

Both of independent claims 8 and 19 recite the step of “transmitting [] multi-media information [] to said player tracking device.” However, the Office Action fails to point out where such a step exists in either Hedrick or Raven. Applicants respectfully submit that

neither Hedrick nor Raven teaches such a step. Because this material element is not present in the prior art, the pending obviousness rejections cannot stand for this reason as well.

- Storing Multi-Media at Player Tracking Device

Independent claim 19 also recites the step of “storing said multi-media information at said player tracking device.” However, the Office Action again fails to point out where such a step exists in either Hedrick or Raven. Applicants respectfully submit that neither Hedrick nor Raven teaches such a step. Because this material element is not present in the prior art, the pending obviousness rejection for claim 19 cannot stand for this reason as well.

- Periodically Accessing Stored Multi-Media

Finally, independent claim 19 also recites the step of “periodically accessing stored multi-media information located at said player tracking device.” As in the foregoing items, the Office Action again fails to point out where such a step exists in either Hedrick or Raven. Applicants respectfully submit that neither Hedrick nor Raven teaches such a step. Because this material element is not present in the prior art, the pending obviousness rejection for claim 19 cannot stand for this additional reason as well.

- Dependent Claims

As detailed above, independent claims 1, 8 and 19 are patentable over the recited prior art for a variety of independently allowable reasons. Dependent claims 2-5 and 7 depend from claim 1, while dependent claims 9-10 and 13-16 depend from claim 8. Accordingly, Applicants respectfully submit that claims 2-5, 7, 9-10 and 13-16 are each patentable over the prior art for at least the same reasons as those provided for claims 1 and 8, and thus request the withdrawal of the § 103 rejections with respect to these claims for at least these reasons.

In addition to the foregoing reasons, many of these dependent claims also contain additional elements that have not been shown to be present in either Hedrick or Raven. For example, claims 2 and 9 recite, “eligibility [is determined] in response to an indication [of] a

player [] playing said gaming device,” claim 5 recites “information host is adapted to generate information regarding a player promotion,” claim 10 recites “said indication comprises the transmission of player identification information from said player tracking device to said player tracking host,” and claim 16 recites, “wherein said multi-media information comprises information regarding a bonus.” Applicants respectfully submit that these dependent claims are also allowable over the prior art for these added limitations, which have not been shown to be present in the prior art.

Regarding dependent claims 14 and 15, the Office Action states that “it would be obvious to a person of ordinary skill in the art at the time of the invention to display promotional information and advertisements by means of these types of determinations in order to make the game more player specific.” Applicants respectfully submit that no proper basis and no proper motivation for making these obviousness rejections have been provided. Applicants again point out that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine reference teachings, and that a proffered combination of prior art references must teach or suggest *all* of the claim limitations. *See* MPEP § 2143. Accordingly, Applicants respectfully submit that these dependent claims are allowable over the prior art for these added limitations, in addition to the reasons provided above for independent claim 8 from which they depend.

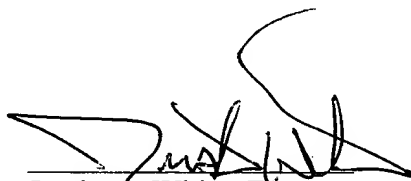
II. New Claims

Claims 21-26 are new. Support for these new claims can be found throughout the specification as filed and the claims as originally filed. Applicants respectfully submit that these new claims are also patentable over the prior art, for at least the same reasons as those discussed above for claims 8-10, 13-16 and 19.

CONCLUSION

Applicants respectfully submit that all claims are in proper form and condition for patentability and thus request a Notification of Allowance to that effect. It is believed that no fee is due at this time. Should any fee be required for any reason related to this paper or application, however, then the Commissioner is hereby authorized to charge said fee to Deposit Account No. 50-0388, referencing Docket No. IGT1P128X2. The Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below with any questions or concerns relating to this paper or application.

Respectfully Submitted,
BEYER WEAVER & THOMAS, LLP

A handwritten signature in black ink, appearing to read 'Justin A. White', is written over a horizontal line.

Justin A. White, Esq.
Reg. No. 48,883

Date: June 24, 2004

Beyer, Weaver & Thomas LLP
P.O. Box 778
Berkeley, California 94704-0778
(650) 961-8300